



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,316	04/07/2000	Brian Dale Ross	252/199	1922

22249 7590 06/20/2002

LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES, CA 90071

EXAMINER

HUYNH, THU V

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,316

Applicant(s)

ROSS ET AL.

Examiner

Thu V Huynh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-12,15,16,19,20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-12,15,16,19,20,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for reconsideration on 03/26/2002 to the application filed on 04/07/2000.
2. Claims 1, 3-6, 8-12, 15, 16, 19, 20, 23, 24 are pending in the case. Claims 1, and 9 are independent claims.
3. Examiner uses non-patent references which are submitted by Applicants on 03/26/2002 in order to provide a consistent frame of reference for the page numbers and line numbers as applicants' request.
4. The objection of claim 39, under 35 U.S.C 112, second paragraph, as being indefinite has been withdrawn as pursuant to the applicant's argument.
5. The rejection of claims 1, 3, 5, 6, and 8-12, 15, 19, 20, 23, and 24 under 35 U.S.C. 103(a) as being unpatentable over Maddison et al., "Peer review", copyright 1998, pages 1-3 in view of Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, pages 1-10, Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21, and Walker et al., U.S. 5,862,223 filed 07/1996 have been withdrawn upon reconsideration.
6. The rejection of claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pope, Maddison, Mathews, Walker as applied to claim 3 above, and further in view of Sato et al., U.S. 6,212,517 B1 filed 06/1998 has been withdrawn upon reconsideration.
7. The rejection of claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pope, Maddison, Mathews, Walker as applied to claim 9 above, and further in view of Sato and Sumner et al. (hereinafter Sumner), "Open Peer Review & Argumentation: Loosening the Pager Chains on Journals", September 1996, pages 1-10 has been withdrawn upon reconsideration.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maddison et al.**, “Peer review”, copyright 1998, pages 1-3 in view of **Pope et al.**, “Using the web for peer review and publication of scientific journals”, September 1998, pages 1-10, **Mathews et al.**, “Electronic Management of the Peer Review Process”, May 6-10, 1996, pages 1-21, **Kao et al.**, US 6,070,177 filed 03/1998, **Sumner et al.**, “Open Peer Review & Argumentation: Loosening the Pager Chains on Journals”, September 1996, page 1-10, and **Walker et al.**, U.S. 5,862,223 filed 07/1996.

Regarding independent claim 1, Maddison teaches the steps of:

- assigning a qualified reviewer to the article (Maddison, page 2, lines 26-30, teaches that the step of assigning reviewers to review the article based on the reviewers’ expertise and the subject of the article).
- providing an evaluation form to the reviewer (Maddison, page 2, lines 35-37);

Art Unit: 2176

- receiving a completed evaluation from the reviewer (Maddison, page 2, lines 35-37 and page 3, line 1, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished ...”);
- providing the completed evaluation form to the author (Maddison, page 2, lines 27-29 and 33, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished by the reviewer are passed along to the author”);
- receiving a response from the author (Maddison, page 3, lines 1-7, teaches that the author responses to the reviewers when the author decline to make the requested changes from the reviewer);
- providing the author responses to an editor (Maddison, page 3, lines 1-7, teaches that the editors consider the author response); and
- receiving a publication decision from the editor (Maddison, page 2, lines 8-10 and 16-17, pages are marked with peer review icon is the version ready to be publish; page 3, lines 3-11, teaches that “page is awarded the peer review mark once authors have made all the changes and additions *required by the editor*).

Maddison does not explicitly teaches receiving an article from an author via communication network; querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; providing the completed evaluation with author responses to an editor; and providing the publication decision to the author and the review.

Pope teaches the steps of:

- receiving an article from an author via a communication network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal).

Art Unit: 2176

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope and Maddison to make Maddison's peer review process on-line, as Maddison disclosed "reviews are usually conducted on-line" (page 2, line 35), as Pope disclosed "made it possible to conduct the entire peer-review process on-line" (page 1, lines 6-7).

However, Pope does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; providing the completed evaluation with author responses to an editor; and providing the publication decision to the author and the review.

Mathews teaches peer review process includes the steps of:

- providing an evaluation form to the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33, providing an evaluation form which includes several criteria rating and comments field to the reviewer);
- receiving a completed evaluation form from the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the completed evaluation form to the author (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the publication decision to the author and the reviewer (Mathew, page 8, lines 25-37, teaches that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Mathews into Maddison and Pope to provide the

Art Unit: 2176

announcement of the result for the authors as well as the reviewers, since in the business practice, both the reviewers and the authors are people who expect the result.

However, Mathews does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer; receiving a response from the author directly in the completed evaluation form; and providing the completed evaluation with author responses to an editor.

Kao teaches a form is transmitted among several user to review includes comments which are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Kao into Maddison, Pope and Mathews to allow the author responses to the reviewers evaluation form directly in the completed evaluation form and providing the completed evaluation with author responses to an editor to facilitate the peer review process, since this would have helped the reviewers, authors, and editor are able to use the evaluation form to communicate to each other in peer review conducted on-line.

However Kao does not explicitly disclose the steps of querying a database of potential reviewers to determine a qualified reviewer.

Sumner teaches, “automated systems are in place for matching reviewers with submissions based on keyword analysis” (Sumner, page 2, lines 7-8); and “the editor then decides whether the article should be accepted ... for publication with the final article (Sumner, page 7, line 13 – page 8, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sumner into Maddison, Pope, Mathew, and Kao to

Art Unit: 2176

provide an automated system to determine a qualified reviewer for an article based on keyword analysis, since this would have facilitate the peer review process.

However, Sumner does not explicitly disclose the step of querying a database of potential reviewers to determine a qualified reviewer.

Walker teaches the step of:

- querying a database of potential reviewers to determine a qualified reviewer (Walker, col.7, lines 32-61).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker's search program to identify qualified experts into Maddison, Pope, Mathews, Kao and Sumner's peer review process to provide a way to find a qualified reviewer to review the article as Walker disclosed "a simple way for users to find qualified experts to give them professional advice" (Walker, col.7, lines 1-5).

Regarding dependent claim 3, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, and Walker teach the limitations as explained above. Walker teaches that the qualified reviewer is determined according to availability and past performance, including, experience, availability criteria, response time, prior work history, skill sets, prior work history (Walker, col.14, line 66 – col.15, line 7; col.17, lines 44-53; and col.41, claim 3).

Walker does not explicitly state "timeliness, thoroughness, clarity, and the number of completed reviews" criteria are use to determine the qualified reviewer.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Walker's criteria for a qualified expert which includes "timeliness, thoroughness, clarity, and the number of completed reviews" because Walker's

Art Unit: 2176

criteria for a qualified expert, such as “response time, experience, skill sets, and prior work history” suggest “timeliness, thoroughness, clarity, and the number of completed reviews” criteria becomes conditions for searching an expert for reviewing a particular article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker into Maddison, Pope, Mathews, Kao, Sumner to find a potential reviewer among others to review the particular article, since it would have provide proper evaluation for the article.

Regarding dependent claim 5, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, and Walker teach the limitations as explained above. The limitation of “receiving comments entered directly into the evaluation form” is addressed under the same rationale as provided above in the rejection of claim 1.

Regarding dependent claim 6, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, and Walker teach the limitation of claim 1 as explained above. Maddison does not explicitly disclose the steps of automatically reformatting the article into a standard format and presenting the formatted article to the author for approval.

Pope also teaches the steps of:

- automatically reformatting the article into a standard format (Pope, page 3, lines 1-27, teaches that the software “mounts an HTML version of the complete article”).
- presenting the final version article to the author for approval (Pope, page 7, lines 7-9).

However, Pope does not explicitly disclose presenting the *reformatted article* to the author for approval.

Art Unit: 2176

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have including the step of presenting the reformatted article to the author for approval in a peer review process because Pope teaches presenting the *final version article* to the author for approval, which suggests the reformatted article is also approved by the author to reduce mistakes or any improper from the reformat process.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope into Maddison, Mathews, Kao, Sumner, and Walker to make a peer review process on-line applicable to any type of journal publication, since “reformat into a standard format” would have helped different kind of journals converts the submitted article to satisfy the format requirements.

Regarding dependent claim 8, which is dependent on claim 1, Maddison, Pope, Mathews, Kao, Sumner, and Walker teach the limitations as explained above. Refer to the rationale relied to reject claim 1, the step of “informing the author of the publication decision by email” is addressed. The rationale is incorporated herein.

10. Claims 9-12, 15, 19-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope et al., “Using the web for peer review and publication of scientific journals”, September 1998, pages 1-10, in view of Maddison et al., “Peer review”, copyright 1998, pages 1-3, Mathews et al., “Electronic Management of the Peer Review Process”, May 6-10, 1996, pages 1-21, Kao et al., US 6,070,177 filed 03/1998, Sumner et al., “Open Peer Review & Argumentation: Loosening the Pager Chains on Journals”, September 1996, page 1-10, and Walker et al., U.S. 5,862,223 filed 07/1996.

Art Unit: 2176

Regarding independent claim 9, Pope teaches the steps of:

- receiving an article from an author via a communications network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal).
- receiving an agreement from one or more qualified reviewers (Pope, page 5, lines 1-4, teaches the software keeps track of “who has agreed to review” and “who has not yet responded the request”, which implies one or more qualified reviewers responses the request for agreement).
- contacting each qualified reviewer and requesting that the qualified reviewer agree to review the article (Pope, page 5, lines 1-8, teaches the software contacts the required number of reviewers).

Pope does not teach the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; providing an evaluation form to the accepting qualified reviewer; receiving a completed evaluation form from the accepting qualified reviewer; providing the author with the completed evaluation form; receiving a response from the author directly in the completed evaluation; providing the completed evaluation form with author response to an editor; receiving a publication decision from the editor; and providing the publication decision to the author and the reviewer.

Maddison teaches the steps of:

- providing an evaluation form to the accepting qualified reviewer (Maddison, page 2, lines 35-37);

Art Unit: 2176

- receiving a completed evaluation form from the accepting qualified reviewer (Maddison, page 2, lines 35-37 and page 3, line 1, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished ...”);
- providing the author with the completed evaluation form (Maddison, page 2, lines 27-29 and 33, teaches “the reviewer typing comments ... evaluation form” and “the comments furnished by the reviewer are passed along to the author”);
- receiving a response from the author (Maddison, page 3, lines 1-7, teaches that the author responses to the reviewers when the author decline to make the requested changes from the reviewer);
- providing the author responses to an editor (Maddison, page 3, lines 1-7, teaches that the editors consider the author response);
- receiving a publication decision from the editor (Maddison, page 2, lines 8-10 and 16-17, pages are marked with peer review icon is the version ready to be publish; page 3, lines 3-11, teaches that “page is awarded the peer review mark once authors have made all the changes and additions *required by the editor*”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to provide the advantages of peer review process online, since both Maddison and Pope’s purpose is “conduct the entire peer review process online” as Pope disclosed on page 1, lines 6-7. As Maddison disclosed, “Reviews are usually conducted on-line” (Maddison, page 2, lines 26).

However, Maddison does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; receiving a response from the author directly in the completed

Art Unit: 2176

evaluation; providing the completed evaluation form with author response to an editor; receiving a publication decision from the editor; and providing the publication decision to the author and the reviewer.

Mathews teaches peer review process includes the steps of:

- providing an evaluation form to the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33, providing an evaluation form which includes several criteria rating and comments field to the reviewer);
- receiving a completed evaluation form from the reviewer (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the completed evaluation form to the author (Mathews, page 3, lines 33-35 and page 7, lines 22-33; the score and the comments are mailed to the author);
- providing the publication decision to the author and the reviewer (Mathew, page 8, lines 25-37, teaches that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Mathews into Maddison and Pope to provide the announcement of the result for the authors as well as the reviewers, in the business practice, both the reviewers and the authors are people who expect the result.

However, Mathews does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; providing the article to an accepting qualified reviewer; receiving a response from the author directly in the completed evaluation; providing the completed evaluation form with author response to an editor; and receiving a publication decision from the editor.

Art Unit: 2176

Kao teaches a form is transmitted among several user to review includes comments which are entered directly in the form (Kao, col.5, lines 8-10; col.6, lines 17-40; and fig.4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Kao into Pope, Maddison, and Mathews to allow the author responses to the reviewers evaluation form directly in the completed evaluation form and providing the completed evaluation with author responses to an editor to facilitate the peer review process, since this would have helped the reviewers, authors, and editor are able to use the evaluation form to communicate to each other in peer review conducted on-line.

However Kao does not explicitly disclose the steps of searching a database of potential reviewers; generating a ranked list of qualified reviewer; and providing the article to an accepting qualified reviewer.

Sumner teaches, “automated systems are in place for matching reviewers with submissions based on keyword analysis” (Sumner, page 2, lines 7-8); and “the editor then decides whether the article should be accepted ... for publication with the final article (Sumner, page 7, line 13 – page 8, line 2).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sumner into Pope, Maddison, Mathews, and Kao to provide an automated system to determine a qualified reviewer for an article based on keyword analysis, since this would have facilitate the peer review process.

However, Sumner does not explicitly disclose the step of searching a database of potential reviewers; generating a ranked list of qualified reviewer; and providing the article to an accepting qualified reviewer.

Walker teaches the steps of:

Art Unit: 2176

- searching a database of potential reviewers (Walker, col.7, lines 32-61; col.17, lines 43-45; and col.20, lines 32-35, teaches searching the database to generate a list of qualified reviewers);
- generating a ranked list of qualified reviewers (Walker, col.25, lines 35-44, teaches displaying a rated list of qualified expert, “expert qualification levels is display ... Once a level of expertise has been selected ... a list of expert Ids is display ... rating for that expert may be available); and
- providing the article to an qualified reviewer (Walker, col.9, lines 40-50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Walker’s search program to identify qualified experts into Maddison, Pope, Mathews, and Sumner’s peer review process to provide a way to find a qualified reviewer to review the article as Walker disclosed “a simple way for users to find qualified experts to give them professional advice” (Walker, col.7, lines 1-5) as well as to improve peer review process by Walker’s search program to generate “a *prioritized* list of potential reviewers” as Pope disclosed on page 4, lines 8-10.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the step of *providing the article to an accepting qualified reviewer* in Pope, Maddison, Mathews, Kao, Sumner’s peer-review process as Mathews disclosed “ ... a reviewer to view or print the entire paper ... ” (Mathews, page 6, line 8) after the author submitted the article, since it is impossible for a qualified reviewer to review/evaluate an article without see its content.

Regarding dependent claim 10, which is dependent on claim 9, Pope, Maddison,

Art Unit: 2176

Mathews, Kao, Sumner, and Walker teach the limitation as explained above. Refer to the rationale relied to reject claim 9, the limitation of “the accepting qualified reviewers complete the evaluation form online” is addressed. As Pope disclosed “made it possible to conduct the entire peer-review process on-line” (Pope, page 1, lines 46-7).

Regarding dependent claim 11, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, and Walker teach the limitation as explained above. Pope does not teaches that each accepting qualified reviewer for an article has access to completed evaluation forms of other accepting qualified reviewers after submitting an evaluation form for the same article.

Mathews teaches the reviewers are able to access to the Web site to update the reviews or examine submissions (Mathews, page 7, lines 19-20, “every paper must be reviewed by at least two reviewers”; and page 17, lines 15-21, “reviewers with limited access (update reviews, examiner submissions, etc)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Mathews and Pope to provide the reviewers a level degree access, such as the reviewers are able to access other evaluation forms, since this would have allowed the reviewer to know other evaluation opinion on the same article.

However, Mathews does not explicitly disclose accessing other completed evaluation form after submitting an evaluation form for the same article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have appreciated that the reviewer has access to completed evaluation forms of other accepting qualified reviewers after submitting an evaluation form for the same

Art Unit: 2176

article to provide honesty evaluation, since examining other completed evaluation form for the same article before evaluate and submit it would have influenced the reviewer' point of view in evaluating process.

Regarding dependent claim 12, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, and Walker teach the limitation as explained above. Pope does not explicitly disclose that each accepting qualified reviewer can set access privileges for a section of the reviewer's completed evaluation form.

Maddison teaches that each accepting qualified reviewer have the option of revealing their identity or not to the author (Maddison, page 2, lines 30-34). Maddison does not explicitly teach that each reviewer can "set access privilege for a section of the reviewer's completed evaluation form". However, the ability to "set access privilege for a section of the reviewer's completed evaluation form" would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Maddison, because Maddison teaches that the reviewers have "option of revealing their identity" or not to the authors, which suggest the ability to set any type of confidential information should be protected in order to evaluate the article to the author, providing integrity of work.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to increase the accuracy of the information presented in the article, protect the reviewers privacy and objectivity, since "setting confidential for sections of the reviewer's completed form" would have helped the reviewers openly evaluate the article.

Art Unit: 2176

Regarding dependent claim 15, which is dependent on claim 9, Pope, Maddison, Mathews, Kao, Sumner, and Walker teach the limitation of claim 9 as explained above. Pope also teaches that reformatting the article into a standard format (Pope, page 3, line 1-26, Pope teaches that “the above formatting provisions allow the software to: mounts an HTML version of the complete article”).

Regarding dependent claim 19, which is dependent on claim 9 Pope, Maddison, Mathews, Kao, Sumner, and Walker teach the limitation of claim 9 as explained above. Pope teaches that the article iterates through the peer review process until the article is approved for publication (Pope, page 1, lines 1-12).

Regarding dependent claim 20, which is dependent on claim 19, Pope, Maddison, Mathews, Kao, Sumner, and Walker teach the limitation of claim 19 as explained above. Pope teaches that after the article has been approved for publication, further comprising the steps of:

- creating a galley proof of the article (Pope, page 7, lines 7-12).
- providing the galley proof of the author (Pope, page 7, lines 7-12).
- receiving an approval of the galley proof from the author (Pope, page 7, lines 7-12).
- immediately publishing the article in electronic format (Pope, page 7, lines 7-12).

However, Pope does not teach proving the galley proof to the *editor* for an approval.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included the step of proving the galley proof to the editor for an approval before publishing the article to increase the accuracy of the information presented in the article, since both the author and the editor are people who has knowledge/experience with the

Art Unit: 2176

article. As Pope disclosed, "Once the reviews are submitted, the subject editors has made a recommendation" (Pope, page 6, line 11).

Regarding dependent claim 23, which is dependent on claim 9, Pope, Maddison Mathews, Kao, Sumner, and Walker teach the limitations as explained above. Pope teaches receiving an article from an author via a communication network (Pope, page 2, lines 28-31, teaches the step of using the network to submit an article to a journal).

Pope does not explicitly disclose receiving a co-authored article.

Maddison teaches peer review process in which authors work on a book (Maddison, page 1, lines 10-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Maddison and Pope to facilitate the peer review process when the big project, such as journal or Madison's book is working on, which need many author's knowledge, since the entire Maddison's peer review process on-line, the co-authors are more convenient to contact each other as well as submit a part of article or respond to the reviewers.

Regarding dependent claim 24, which is dependent on claim 23, Maddison, Pope, Mathews and Walker teach the limitations as explained above. Pope does not explicitly disclose the step of receiving a response from each co-author directly in the completed evaluation form. Refer to the rejection of claim 9, Pope in view of Maddison, Mathews, and Kao teach "receiving a response from the author directly in the completed evaluation form" as explained above.

Art Unit: 2176

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Maddison into Pope, Mathews, and Kao to facilitate the peer review process as well as communication between reviewers and co-author, since all co-authors and reviewers are able to access to the evaluation form.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddison in view of Pope, Mathews, Kao, Sumner, and Walker as applied to claim 3 above, and further in view of Sato et al., US 6,212,517 B1 filed 06/1998.

Regarding dependent claim 4, which is dependent on claim 3, Maddison in view of Pope, Mathews, Kao, Sumner and Walker teach the limitation of claim 3 as explained above. Maddison does not disclose the steps of generating a ranked list of keywords related to the article; providing the list of keywords to the author; and receiving an approval of the ranked list from the author.

Sato teaches the steps of:

- generating a ranked list of keywords related to a selected document/text (Sato, col.1, lines 9-11 and 53-61; and col.8, lines 16-20).
- providing the list of keywords to the user (Sato, col.1, lines 9-11, “providing a list of keywords ranked”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sato and Pope to provide keyword information to the author as Pope disclosed “create ... keywords ... information ... for use in messages to authors” (Pope, page 3, lines 23-24).

However, Sato does not disclose the step of receiving an approval of the ranked list from

Art Unit: 2176

the author.

Pope teaches the step of:

- receiving an approval of the *final version article* from the author (Pope, page 7, lines 7-9).

However, Pope does explicitly disclose receiving an approval of the *ranked list* from the author.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have including the step of presenting the *ranked list* of keywords to the author for approval in a peer review process because Pope teaches presenting the *final version article* to the author for approval, which suggests the *ranked list* is also approved by the author to reduce mistakes or any improper from ranking process.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope and Sato into Maddison, Mathews, Kao and Walker to make a peer review process on-line more accurate, since both system and author agree the article content based on ranked list of keywords.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of Maddison, Mathews, Kao, Sumner, and Walker as applied to claim 9 above, and further in view of Sato et al., US 6,212,517 B1 filed 06/1998.

Regarding dependent claim 16, which is dependent on claim 9, Pope in view of Maddison, Mathews, Kao, Sumner, and Walker teach the limitation of claim 9 as explained above. Refer to the rejection of claim 9, in which “searching the database to generate a list of qualified reviewers” is addressed. The rationale is incorporated herein.

Art Unit: 2176

Pope does not explicitly disclose the steps of parsing the title and text of the article to generate a list of keywords; and ranking the list of keywords according to their relative weight in describing the content of the article.

Sumner teaches that “Sometimes, automated systems are in place for matching reviewers with submission based on keyword analysis” (Sumner, page 2, lines 7-8), which implies the step of parsing the article, such as the title, abstract, and text content to find article’s keywords for matching the reviewer records.

However, Sumner does not teach the step of ranking the list of keywords according to their relative weight in describing the content of the article.

Sato teaches the step of ranking the list of keywords according to their relative weight in a selected document/text (Sato, col.1, lines 19-11 and 53-61; and col.8, lines 16-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sato and Sumner to provide more clearly the main content of the submitted article, since article’s keywords are provided “in order of importance”.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sumner and Sato into Pope, Maddison, Mathews, Kao, Walker to provide an automatically selection of potential reviewers to review the particular submitted article based on the keywords which are parsed from the submitted article, as Maddison disclosed “ the major criterion for the selection of potential reviewers is their scholarly expertise as demonstrated by their publication record on the organisms represented on the page to be reviewed” (Maddison, page 2, lines 28-30). As Pope disclosed on page 3, lines 17-25, “create ASCII versions of acknowledgments, abstract, keywords, ...” after the authors submit their articles.

Response to Arguments

13. Applicant's arguments filed 03/26/2002 have been fully considered.

Applicants argue with respect claim 1:

- Applicants argue that “The Maddison reference, however, does not disclose a computer implemented step for assigning a qualified reviewer to review the article.

The Examiner cites Madison as teaching this step”.

This is not persuasive. Although Maddison does not explicitly mentions that his system “assigns a qualified reviewer to review the article”, he does mentions that “reviewers are chosen by the editor-in-chief ...” It is conceivably understanding that the process of selecting reviewers should be perform online since Maddison also mention that “reviews are usually conducted online” (Maddison, page 2, line 35). Furthermore, Pop mentions that his teaching “conduct[s] the entire peer-review process online” (Pop, page 1, line 6). Walker’s implementation clearly teaches “a simple way for users to find qualified experts to give them professional advice” (Walker, col.7, lines 1-5) by “querying a database of potential reviewers to determine a qualified reviewer” (Walker, col.7, lines 32-61).

Applicant’s argument that Walker invention is unrelated to the art is non-sense, and the fact that examiner overlooked his invention the first time does not and will not exclude his teaching in facilitating and supporting expert-based system which is directly related to the art.

- Applicants argue that Maddison does not teach the steps of “providing the completed evaluation form to the author”.

Art Unit: 2176

This is not persuasive. From Maddison's structured evaluation form, all data (comments, reviews, etc.) "furnished by the reviewers are passed along to the authors" (Maddison, page 3, line 1), the presentation of these data on the author side must be organized in some *conceivable form*. Otherwise, scattered data will confuse the author, and does not serve its use. In the applicants claim, it is also understandable it is *not the same exact form* that is filled up by the reviewer that is passed to the author, without any modification to reorganize the different fields and make space for further discussion by the author. The representation of form data should not be confused with the "providing" those data (evaluation) back to the author for further discussion as claimed by applicants. Note that the applicants' specification read "the author connects to the Web site and reads *the evaluation*" (applicants, page 18, line 16). Figures 4C and 5A provided by applicants clearly show the evaluation data on two different (technically) forms.

- Applicants argue that Maddison does not teach the steps of "providing a completed evaluation form, including reviewer comments and author responses, to an editor, as claimed in claim 1".

The combination of Maddison, Pope, Mathews and Kao teaches this limitation as mentioned in claim 1 (see office action above).

- Applicants argue that "an editor examining the evaluation form does not teach the step of receiving a publication decision from the editor".

This is not persuasive. Maddison teaches that editor-in-chief considers author's arguments and reviewer's comments as explained above. Maddison specifically teaches

that a peer-reviewed is marked for the article “once authors have made all the changes and additions required by the editor” (Maddison, page 3, lines 10-11). Maddison also teaches that “peer-reviewed version is ready to be published” (Maddison, page 2, lines 11). Therefore, the editor’s decision of whether the publication is ready to be published. It is unimaginable to examiner that the editor would tell a HTML programmer to manually modify the page code to include the ready-to-publish (peer-reviewed) icon as thought by applicants.

- Applicants argue that the judgment on obviousness is “no way whatsoever disclosed or even implied by the Maddison reference” for the limitation of “receiving a response from the author directly in the completed evaluation form”.

The combination of Maddison, Pope, Mathews and Kao teaches this limitation as mentioned in claim 1 (see office action above).

Applicants argue with respect claim 9:

- Applicants states that “The Examiner cites no reference that includes the step of providing the article to an accepting qualified reviewer. Therefore, ... claim 9 is presently in condition for allowance ... ”.

This is not persuasive. This step must be implied in Pope’s teaching since Pope’s peer review system allows the entire process to be carried online. The system must provide a qualified reviewer the article for him/her to review/evaluate it. See office action above.

Art Unit: 2176

- Applicants argue that “Walker contains no teaching, suggestion, discussion or other indication that the resulting list would be in any way ranked”.

This is not persuasive. Walker implementation classify expert in different levels, which are considered a form of rankings (Walker, col.25, lines 35-44). Other qualifications such as professional, academic, licenses, degrees, experience, etc. are also maintained by the Walker system (Walker, col.14, line 67 to col.15 line 3). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Walker to rank experts by any desired levels into any categories. Applicants argue that examiner “suggest[s] that the resulting list could be ranked by price”, which indeed is one of a conceivable type of ranking. Walker implementation directly suggests the ranking of experts (or reviewers).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu v Huynh whose telephone number is (703) 305-9774. The examiner can normally be reached on Monday through Friday, except the second Friday of each bi-week.

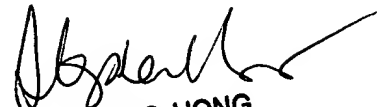
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications (703) 746-7238 for After Final communications, and (703) 746-7240 for Non-Official/Draft.

Art Unit: 2176

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

TVH

June 17, 2002



STEPHEN S. HONG
PRIMARY EXAMINER